

REMARKS

The Examiner objected claims to 23 and 24 under 37 CFR 1.75(c), as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. In response, Applicants have amended claim 23 to clarify the invention.

The Examiner rejected claims 1-10, 13-22 and 25 under 35 U.S.C. §102(b) as allegedly being anticipated by US Pat. No. 5,838,918 issued to Prager et al.

The Examiner rejected claims 11, 12, 23 and 24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Prager.

Applicants respectfully traverse the §102(b) and §103(a) rejections with the following arguments.

35 U.S.C. §102(b)

The Examiner rejected claims 1-10, 13-22 and 25 under 35 U.S.C. §102(b) as allegedly being anticipated by US Pat. No. 5,838,918 issued to Prager et al.

Applicants respectfully contend that Prager does not anticipate claims 1, 13, and 25, because Prager does not teach each and every feature of claims 1, 13, and 25.

As a first example illustrating that Prager does not teach each and every feature of claims 1, 13, and 25, Prager does not teach the following feature of claim 1 (and similarly for claims 13 and 25): “creating the template based on design information, said creating the template implemented by a template manager”.

The Examiner argues that Prager discloses: “creating the template based on design information, said creating the template implemented by a template manager [col. 5, lines 8-18]”.

In response, Applicants contend that Prager, col. 5, lines 8-18 teaches “defin[ing] a class of template objects” which is not a teaching of “creating the template based on design information” (emphasis added).

In addition, Prager, col. 5, lines 8-18 is totally silent as to said “creating the template implemented by a **template manager**” (emphasis added).

As a second example illustrating that Prager does not teach each and every feature of claims 1, 13, and 25, Prager does not teach the following feature of claim 1 (and similarly for claims 13 and 25): “storing the template in a template manager database, said storing the template implemented by the template manager”.

The Examiner argues that Prager discloses: "storing the template in a template manager database, said storing the template implemented by the template manager [col 5, lines 19-28]".

In response, Applicants contend that Prager, col. 5, lines 19-28 teaches "a central configuration database 400 [that] is maintained as part of a manager machine 405 and contains configuration information of various types which may be used by the various components 105 of the distributed system. Such configuration information may include information usable to configure a component 105 to a specified operational use, e.g., as a "spreadsheet" machine." Applicants maintain that the preceding quote from Prager makes it clear that the "central configuration database" in Prager is not a "template manager database" of the present invention as defined in Applicants' specification, page 5, lines 8-9 as being "a database that includes templates and associated instances".

In addition, Prager, col. 5, lines 19-28 is totally silent as to "storing the template in a **template manager database**" (emphasis added).

In addition, Prager, col. 5, lines 19-28 is totally silent as to "said storing the template implemented by the **template manager**" (emphasis added).

As a third example illustrating that Prager does not teach each and every feature of claims 1, 13, and 25, Prager does not teach the following feature of claim 1 (and similarly for claims 13 and 25): "generating the N instances based on the template and on control information for the N instances, said control information including configuration control information, said configuration control information identifying N locations corresponding to the N instances, said N at least 2, said generating the N instances implemented by the template manager; storing the N

instances in the template manager database, said storing the N instances implemented by the template manager; and transmitting the N instances to the corresponding N locations, said transmitting the N instances implemented by the template manager”.

The Examiner argues that Prager discloses said feature of claims 1, 13, and 25 in Prager, col. 10, lines 24-32.

In response, Applicants contend that Prager, col. 10, lines 24-32 is totally silent as to “generating the N instances ”.

In addition, Prager, col. 10, lines 24-32 is totally silent as to “generating the N instances based on the template and on control information for the N instances” (emphasis added).

In addition, Prager, col. 10, lines 24-32 is totally silent as to “said control information including configuration control information”.

As a fourth example illustrating that Prager does not teach each and every feature of claims 1, 13, and 25, Prager does not teach the following feature of claim 1 (and similarly for claims 13 and 25): “storing the N instances in the template manager database, said storing the N instances implemented by the template manager; ... and transmitting the N instances to the corresponding N locations, said transmitting the N instances implemented by the template manager”.

The Examiner argues that Prager discloses: “storing the template in a template manager database, said storing the template implemented by the template manager [Fig. 10, 200] ... transmitting the N instances to the corresponding N locations, said transmitting the N instances implemented by the template manager [Fig. 10, 200] ”.

In response, Applicants contend that Prager, FIG. 10, reference numeral 200 is "local endpoint's database 200" which is described in Prager, col. 2, lines 44-46 as "contain[ing] the kind of information described earlier, e.g., users, printers, available file systems, etc." The preceding quote from Prager does not support any contention that the local endpoint's database 200 is the "template manager database" that appears in the preceding feature of claims 1, 13, and 25. In addition, Prager, col. 10, lines 30-33 includes the following discussion of the local endpoint's database 200: "the system files and databases modified as a result of this operation are in the local end-point's database 200", which is irrelevant to the preceding feature of claims 1, 13, and 25.

Moreover, Prager's entire discussion of FIG. 10 in col. 9, line 57 - col. 11, line 42 does include any disclosure, and has no relevance to, the preceding feature of claims 1, 13, and 25.

Based on the preceding arguments, Applicants respectfully maintain that Prager does not anticipate claims 1, 13, and 25, and that claims 1, 13, and 25 are in condition for allowance. Since claims 2-10 depend from claim 1, Applicants contend that claims 2-10 are likewise in condition for allowance. Since claims 14-22 depend from claim 13, Applicants contend that claims 14-22 are likewise in condition for allowance.

35 U.S.C. §103(a)

The Examiner rejected claims 11-12 and 23-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Prager.

Since claims 11-12 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Prager under 35 U.S.C. §102(b), Applicants maintain that claims 11-12 are likewise not unpatentable under 35 U.S.C. §103(a).

Since claims 23-24 depend from claim 13, which Applicants have argued *supra* to not be unpatentable over Prager under 35 U.S.C. §102(b), Applicants maintain that claims 23-24 are likewise not unpatentable under 35 U.S.C. §103(a).

In addition with respect to claims 11 and 23, Applicants respectfully contend that the Examiner's argument for modifying Prager is not persuasive. The Examiner argues:

"Prager fails to disclose refreshing M instances of the N instances based on update control information, said $M \leq N$, said refreshing the M instances implemented by the template manager; and transmitting the M refreshed instances to the corresponding M locations; said transmitting the M instances implemented by the template manager.... It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Prager to include refreshing M instances of the N instances based on update control information, said $M < N$, said refreshing the M instances implemented by the template manager; and transmitting the M refreshed instances to the corresponding M locations, said transmitting the M instances implemented by the template manager.... The ordinarily skilled artisan would have been motivated to modify Prager per the above for the purpose of confining updates to those clients who requested the updates."

In response to the preceding argument by the Examiner, Applicants maintain that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Prager as suggested by the Examiner. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests a modification "for the purpose of confining updates to those clients who requested the updates". Thus, the Examiner has provided a reason for the combination based on the Examiner's creativity and speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for the Examiner's suggested modification of Prager, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 11 and 23 .

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

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